



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/807,034	12/09/85	BODOR	N 023800-002

NORMAN H. STEPNO
BURNS, DOANE, SWECKER & MATHIS
GEORGE MASON BLDG.
WASHINGTON & PRINCE STS., P. O. BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER	
LIPOVSKY, J	
ART UNIT	PAPER NUMBER
125	8

DATE MAILED:

03/02/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 1/27 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|------------------------------------------------------------------------------------|---------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-51, 56-63 AND 65-114 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 52-55 AND 64 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-45, 56-63 AND 65-114 are rejected.
5. ☒ Claims 46-51 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable;
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____,
has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However,
the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are
corrected. Corrections **MUST** be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO
EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in
accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Serial No. 807,034

-2-

Art Unit 125

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-45, 56-63 and 65-114 are rejected under 35 U.S.C. 103 as being unpatentable over the references of Phillipps et al. (1 and 2) and Edwards in combination with Sarrett et al. for reasons already of record in the previous Office action. The designated allowability of claims 7 and 90 was in error and has been withdrawn as the rejection is seen to apply equally thereto. Applicant's arguments have been considered but are not seen as persuasive. Applicant and examiner are at issue over the applicability of the teaching of Sarrett et al. The

Serial No. 807,034

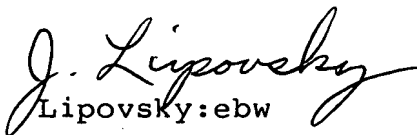
-3-

Art Unit 125


reference teaches the utility of the reaction with steroids in general, with only 16 and 17 position substituents affecting the reaction. The reference further teaches that such a modification produces compounds with high activities. Applicant has failed to show why such a reaction and its activity enhancement of its products would not be expected to work for the broadly claimed compounds at hand.

Claims 46-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Joseph Lipovsky at telephone number 703-557-9590.


Lipovsky:ebw

2/12/87


LEONARD SCHENKMAN
EXAMINER
ART UNIT 125